Supreme Court, U.S.
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No. 03-

IN THE

Supreme Court of the United States

LAFACE RECORDS, ARISTA RECORDS, INC., BMG ENTERTAINMENT, and OUTKAST,

Petitioners,

v.

ROSA PARKS,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

JOSEPH M. BECK
Counsel of Record
CHRISTOPHER J. KELLNER
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530
(404) 815-6500

Attorneys for Petitioners

183212

COUNSEL PRESS
(800) 274-3321 • (800) 359-6859

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QUESTIONS PRESENTED

1. Whether the lower court unconstitutionally allows public figures to use trademark and right of publicity law to censor speech.

2. Whether the lower court's failure to observe the distinction between commercial and non-commercial speech resulted in creation of a "mutant" and unprecedented civil action that unconstitutionally restricts speech about celebrities.

3. Whether the lower courts' adoption of conflicting permissive and restrictive tests for measuring Trademark Act and right of publicity claims against First Amendment standards threatens constitutionally-protected expression.

STATEMENT PURSUANT TO RULE 29.6

Petitioner LaFace Records states that its ultimate parent corporation is Bertelsmann AG and that it is not owned in whole or in part by any publicly held company.

Petitioner Arista Records states that its ultimate parent corporation is Bertelsmann AG and that it is not owned in whole or in part by any publicly held company.

Petitioner BMG Entertainment states that its ultimate parent is Bertelsmann AG and that it is not owned in whole or in part by any publicly held company.

Petitioner OutKast states that it has no corporate parent and that it is not owned in whole or in part by any publicly held company.

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STATEMENT OF JURISDICTION

The court of appeals entered its opinion and order on May 12, 2003 and denied rehearing *en banc* on July 2, 2003. Petitioners invoke this Court's jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This case involves the Free Speech Clause of the First Amendment to the United States Constitution and Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a), both of which are reprinted in the Appendix at 83a-84a.

STATEMENT OF THE CASE

1. *Introduction and Summary*

This case presents the following question: Does the First Amendment permit a writer to use a public figure's name symbolically as the title of a work that is perceived as "antithetical" to the image or "qualities" of the public figure? The Sixth Circuit's decision in this case invites a jury to impose liability if it decides that the popular song entitled "Rosa Parks" is "antithetical to the qualities identified with Rosa Parks." *Parks v. LaFace Records*, 329 F.3d 437, 454 (6th Cir. 2003) (Pet. App. 31a).

The record is clear: There is an undeniable and undisputed "relationship" between the title "Rosa Parks" and a song whose chorus repeats ten times "everybody move to the back of the bus." That phrase, "back of the bus," makes an immediate connection with Rosa Parks for anyone who has ever heard of Rosa Parks — whether the phrase is spoken once or ten times. The Sixth Circuit did not disagree, observing that it mattered not whether "the phrase [back of the bus] is repeated ten times or fifty times." *Id.* at 453 (Pet. App. 28a). Rather, for the Sixth Circuit "the **question presented** is how the symbol of Rosa Parks, a symbol of 'freedom, humanity, dignity and strength' is artistically related to the content of a song that appears to be diametrically opposed to those qualities." *Id.* at 456 (emphasis added) (Pet. App. 34a). The Sixth Circuit made the aesthetic judgment that the song was "nothing more and nothing less than a paean announcing the triumph of superior people in the entertainment business over inferior people in that business." *Id.* at 453 (Pet. App. 27a-28a).

Songs such as "Rosa Parks" indisputably receive First Amendment protection, *see Ward v. Rock against Racism*, 491 U.S. 781, 790 (1989), regardless of their content. This court has rejected out of hand any effort to "ensure that a symbol" — be it a flag, Reverend Jerry Falwell or Rosa Parks — "be used to express only one view of that symbol or its referents." *Texas v. Johnson*, 491 U.S. 397, 417 (1989); *see also Hustler Magazine v. Falwell*, 485 U.S. 46 (1988).

The Sixth Circuit purports to adopt the speech protective test set forth by the Second Circuit in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). But under *Rogers*, a title receives full First Amendment protection unless it has "**no** artistic relevance to the underlying work **whatsoever**." *Id.* at 999 (emphasis added). The Sixth Circuit decision, in vivid contrast, invites a jury to compare a work's artistic content to the celebrity's image, at one point going so far as to suggest

that a jury might decide whether the title is "reasonably 'artistic.'" *Parks*, 329 F.3d at 450 (Pet. App. 22a).[1] As a result, the Sixth Circuit ignores this Court's historic warning (albeit in the context of a copyright case) that the judiciary is ill equipped to decide what is and is not "art." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). More importantly, the Sixth Circuit blurs the bright-line rule requiring judicial evaluation of constitutional facts, *see Bose Corp. v. Consumers Union of the United States, Inc.*, 466 U.S. 485, 505 (1984), leaving to "the jury far more leeway to act as censors than is consistent with the protection of the First and Fourteenth Amendments." *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 275 (1971). The result will be to constrict the "breathing space" required for freedom of expression, *see New York Times v. Sullivan*, 376 U.S. 254, 272 (1964), as artists and publishers try to guess how a jury might decide "whether [the] title is reasonably 'artistic,'" *Parks*, 329 F.3d at 450 (Pet. App. 22a), before inevitably opting for the safest artistic speech.

The concerns of *Monitor* and *New York Times* are real and present in this case. The risks are obvious from the Sixth Circuit's opinion, which disparages the song's "profanity," "explicit language," "parental warning," "pure egomania" and "message" of the inferiority and "lesser quality" of bands that compete with OutKast. 329 F.3d at 452-54 (Pet. App. 27a-31a). The Sixth Circuit panel's ultimate view of the song was thinly concealed in its final musing as to whether it "personally regard[ed] [the song] as repulsive trash or a work of genius." *Id.* at 462 (Pet. App. 49a). With all due respect, it is just such judgments that the First Amendment forbids judges and juries to make as a predicate for enjoining protected expression.

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1. Thus, in purporting to reject the so-called "alternative avenues" test (which prohibits use of a celebrity name if there is an alternative), the Sixth Circuit said that such a test would ask courts to determine "not just whether a title is reasonably 'artistic' but whether a title is 'necessary' to communicate the idea." *Id.* at 450 (Pet. App. 22a).

2. *Background of the Case*

The plaintiff in this case, Ms. Rosa Parks, is a public figure whose well-deserved fame "arose from her heroic stance against racial inequality in the South when on December 1, 1955, in Montgomery, Alabama, she refused to give up her seat to a white passenger and move to the back of the bus." *Parks v. LaFace Records*, 76 F. Supp.2d 775, 777 (E.D. Mich. 1999) (Pet. App. 53a). As a result of this courageous act, Ms. Parks and the phrase "back of the bus" have become inextricably linked: part of the lexicon of our American history.[2]

The defendants (and petitioners before this Court) are artists, entertainers, and distributors of popular music. In 1998, they released an album entitled *Aquemini*, consisting of a total of fifteen songs. Track number 3, entitled "Rosa Parks," contains the lyrics recited in the Sixth Circuit opinion in this case. (*See* 329 F.3d at 442-443; Pet. App. 4a-7a). While Ms. Parks is not mentioned by name in the lyrics, the song's chorus is comprised of the words "Ah, ha, hush that fuss. Everybody move to the back of the bus." This chorus is repeated a total of ten times.

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2. Reference materials repeatedly associate Ms. Parks with her refusal to move to the back of the bus. *See Time*, June 14, 1999, at 3 ("[Ms. Parks] refuses to go the **back of the bus** and is arrested . . ." (emphasis added)); 145 Cong. Rec. S2278 (daily ed. Mar. 4, 1999) (statement of Sen. Abraham) ("Rosa Parks refused to . . . go to the **back of the bus**.") (emphasis added). (R. 15: Plaintiff's Stipulated Facts, Exhs. B, C; JA0047, JA0054). *See also* 7 *Grolier Library of Women's Biographies* 167-68 (1998); *Black Women in America: An Historical Encyclopedia* 907 (Hine et al., eds. 1993); *Academic American Encyclopedia* 92 (1997). (R. 25: Defendants' App. Exhs. A1-A3; JA0156 - JA0166). In fact, a search in the NEXIS/LEXIS news database for the name "Rosa Parks" appearing within 10 words of the phrase "back of the bus" produces no fewer than 337 references merely within the years 1990 to 1997 (the year before the album at issue in this litigation was released). (R. 25: Defendants' App. Exh. A4; JA0168).

The band OutKast, the *Aquemini* album, and the song "Rosa Parks" have all received widespread critical acclaim within the music industry and from the general public, including for the music's "social consciousness."[3] The song "Rosa Parks" was nominated for a Grammy Award. (*See* R. 15: Plaintiff's Stipulated Facts ¶ 43; JA0039).

On April 1, 1999, Ms. Parks filed suit in the Wayne County Circuit Court for the State of Michigan against the band OutKast, LaFace Records, Arista Records, and BMG Entertainment (collectively, "Defendants").[4] Ms. Parks' suit alleged that by naming their song "Rosa Parks" Defendants

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3. *See* Chris Vognar, *Dallas Morning News*, Dec. 24, 1998, at 27A. *See also Los Angeles Times*, Sept. 27, 1998, at 68 ("Tackling topics such as emancipation, drug addiction and problematic relationships [Outkast] explore[s] the bleakest aspects of humanity while encouraging their listeners to examine themselves"); Greg Kot, *Chicago Tribune*, Dec. 20, 1998, at C12 ("[Outkast's] spirited vocals are performed against a backdrop of live instruments that draw on a century of tradition. . . ."); "The Albums Of The Year," *University Wire*, Dec. 8, 1998 ("This album features thought-provoking lyrics, catchy beats and choruses and a comprehensive understanding of the current state of Black America. . . ."); Sheila Simmons, "Outkast: A Bridge For The Ages," *The Plain Dealer*, Mar. 10, 1999, at 3G ("Over funky, soulful beats, Outkast tackled issues about street survival as well as diplomas and SATs. . . . **The line, from the album's debut single, 'Rosa Parks' . . . taught younger listeners about the civil rights activist for whom the song is named.**"); Michael Hewlett, "Innovative Rap Duo Is Outkast In Name Only," *Greensboro News and Record*, Mar. 11, 1999, at 4 ("Musically innovative, the group sneaks in positive messages. . . ."); Sonia Murray, *Atlanta Journal and Constitution*, Oct. 1, 1998, at 4E ("**And, no, Outkast isn't about shooting and robbing like much West Coast gangster rap**. . . .") (all emphases added).

4. Antonio "L.A." Reid and Kenny "Babyface" Edmonds are listed as defendants in the case caption, but were never served and are not a part of this lawsuit in their individual capacity, as the Sixth Circuit noted. 329 F.3d at 442 n.1 (Pet. App. 4a).

violated her publicity rights, engaged in unfair competition, and defamed her, among other state law claims. Defendants properly removed the case to the United States District Court for the Eastern District of Michigan. On November 18, 1999, the District Court entered summary judgment in Defendants' favor on all counts.

In reaching its conclusion, the District Court followed *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). The *Rogers* court was faced with claims by dancing great Ginger Rogers, who alleged, *inter alia*, violation of the Trademark Act and her right of publicity by a film entitled "Ginger and Fred" that was not "about" her, or her partner Fred Astaire, but rather was about two cabaret dancers who became known as "Ginger and Fred." *Id.* at 997. The *Rogers* court announced and applied a legal standard shielding artistic uses of celebrity names in titles unless the celebrity's name has "no artistic relevance to the underlying work whatsoever." *Id.* at 999. Applying this legal standard, the District Court properly reasoned that:

> There can be no reasonable dispute that Rosa Parks is universally known for and commonly associated with her refusal in late 1955 to . . . obey the segregation laws in Montgomery, Alabama and "move to the back of the bus." The song at issue makes unmistakable reference to that symbolic act a total of ten times. Admittedly, the song is not about [Ms. Parks] in a strictly biographical sense, but it need not be. Rather, defendants' use of plaintiff's name, along with the phrase "move to the back of the bus," is metaphorical and symbolic. As a matter of law, this obvious relationship between the content of the song and its title bearing plaintiff's name renders the right of publicity inapplicable.

76 F. Supp.2d at 780 (Pet. App. 60a). The District Court likewise dismissed Ms. Parks' Trademark Act claims because the title

was found to have artistic relevance to the underlying work. 76 F. Supp.2d at 782-83 (Pet. App. 64a-67a). The District Court refused the plaintiff's invitation to render artistic judgment on Defendants' musical work, noting that:

> It is fundamental that courts may not muffle expression by passing judgment on its skill or clumsiness, its sensitivity or coarseness; nor on whether it pains or pleases. It is enough that the work is a form of expression deserving of substantial freedom both as entertainment and as a form of social and literary criticism.

76 F. Supp.2d at 780-81 (Pet. App. 60a) (quoting *University of Notre Dame Du Lac v. Twentieth Century-Fox Film Corp.*, 256 N.Y.S.2d 301, 307, *aff'd*, 259 N.Y.S.2d 832 (1965)).[5]

The Sixth Circuit reversed entry of summary judgment for both the Trademark Act and right of publicity claims in an opinion charged with improper aesthetic judgments about the song's "profanity," "explicit language," "parental warning," "pure egomania" and "message" of the inferiority and "lesser quality" of OutKast's competitors. 329 F.3d at 452-54 (Pet. App. 27a-31a).

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5. The District Court also dismissed Ms. Parks' defamation claim, concluding that the song

> manifestly contains no factual statements, false or otherwise, about plaintiff. . . . Rather, the song only references plaintiff indirectly through the refrain 'Ah ha, hush that fuss, Everybody move to the back of the bus.' Furthermore, because no portion of defendants' song can be construed as a false factual statement about plaintiff, she, as a public figure, could never prove actual malice.

76 F. Supp.2d at 785-86 (Pet. App. 72a-73a). Finally, the District Court dismissedMs. Parks' remaining state law claims for intentional infliction of emotional distress, intentional interference with business relations, unjust enrichment, negligence, and conspiracy.

REASONS FOR GRANTING THE PETITION

1. The lower court unconstitutionally allows public figures to use civil law — in this case, trademark law and the right of publicity — to censor speech.

New York Times v. Sullivan, of course, dealt with defamation, but the Court's reasoning was not confined to that tort:

> [W]e are compelled by neither precedent nor policy to give any more weight to the epithet 'libel' than we have to other 'mere labels' of state law. Like insurrection, contempt, advocacy of unlawful acts, breach of the peace, obscenity, solicitation of legal business, and the various other formulae for the repression of expression that have been challenged in this Court, libel can claim no talismanic immunity from constitutional limitations. It must be measured by standards that satisfy the First Amendment.

Id. at 269 (internal citations and footnotes omitted). Thus, in *Hustler Magazine v. Falwell*, 485 U.S. 46 (1988), this Court concluded that the tort of intentional infliction of emotional distress could not be used by a public figure to penalize offensive speech.[6]

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6. Some lower courts have been similarly vigilant against civil actions designed to punish or restrict speech. *See Food Lion, Inc. v. Capital Cities/ABC, Inc.*, 194 F.3d 505, 522 (4th Cir. 1999) (plaintiff's reliance on duty of loyalty and trespass theories to challenge undercover investigative report was "an end-run around First Amendment strictures . . . foreclosed by *Hustler*."); *Hoffman v. Capital Cities/ABC Inc.*, 255 F.3d 1180 (9th Cir. 2001) (applying *New York Times v. Sullivan* to a right of publicity challenge to a magazine article).

The parallels between this case, *Sullivan*, and *Hustler* are striking: *Sullivan* involved defamation (also pled by Ms. Parks in this suit); *Hustler* the tort of intentional infliction of emotional distress (also pled by Ms. Parks). In all three cases, a public figure uses a civil tort theory to suppress speech that is critical, offensive or simply unwelcome; in all three cases, the ordinary standards for determining liability are inadequately speech-protective. Only the *Rogers* test of **no** artistic relevance supplies constitutional protection coextensive with *Sullivan* and *Hustler*.

Celebrity and public figure identities are important elements of speech. *See ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 933 (6th Cir. 2003) ("Through their pervasive presence in the media, sports and entertainment celebrities come to symbolize certain ideas and values. Celebrities, then, are an important element of the shared communicative resources of our cultural domain.") (quoting *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 972 (10th Cir. 1996)). *See also White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1512 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc) ("Trademarks are often reflected in the mirror of our popular culture.") (listing numerous examples of trademarks incorporated into titles of literary, cinematic, and musical works).

Given the growing importance of celebrity identities and trademarks in expressive communications, it is important to adhere to a recurring principle in this Court's First Amendment jurisprudence: Legal standards protecting freedom of expression must be clear in order to afford speech "breathing space." *Sullivan*, 376 U.S. at 272. For that reason, the state law requirement of factual error was deemed inadequately protective of "breathing space" in *Sullivan*, and "outrageousness" did not pass constitutional muster in *Hustler*. *See Hustler*, 485 U.S. at 54 ("'Outrageousness'

in the area of political and social discourse has an inherent subjectiveness about it which would allow a jury to impose liability . . . on the basis of their dislike of a particular expression.").

Under the lower court's opinion in this case, trademark and publicity law empower public figures to subject displeasing expression to a formless and subjective inquiry: Is the content of the expression consistent with the public figure's "qualities"? This misguided approach surfaces throughout the Sixth Circuit's opinion:

- "In lyrics that are laced with profanity and in a 'hook' or chorus that is pure egomania, many reasonable people could find that this is a song that is clearly antithetical to the **qualities** identified with Rosa Parks." *Parks*, 329 F.3d at 454 (emphasis added) (Pet. App. 30a-31a).

- "It is titled *Rosa Parks*, and it is difficult to equate OutKast's feeling of superiority, metaphorically or in any other manner, to the **qualities** for which Rosa Parks is known around the world." *Id.* (emphasis added) (Pet. App. 31a).

- "**[T]he question presented** is how the symbol of Rosa Parks, a symbol of 'freedom, humanity, dignity, and strength' is artistically related to the content of a song that appears to be diametrically opposed to those **qualities**." *Id.* at 456 (emphasis added) (Pet. App. 34a).

- "The lyrics' sole message is that OutKast's competitors are of lesser quality and, therefore, must 'move to the back of the bus,' or in other words 'take a back seat.' We believe that reasonable persons could conclude that there is no relationship of any kind between Rosa Parks' name and the **content of the song** — a song that is nothing more and nothing less than a paean announcing

> the triumph of superior people in the entertainment business over inferior people in that business." *Id.* at 452-53 (emphasis added) (Pet. App. 27a-28a).[7]

Petitioners respectfully submit that free-wheeling jury comparisons of an artistic work to a celebrity's "qualities" will pose the same kind of threat to artistic speech as was recognized and thwarted by this Court in *Sullivan* and *Hustler*.

Proper application of the *Rogers* test to artistic speech provides the bright-line, speech-protective rule long mandated by this Court's First Amendment jurisprudence. The Sixth Circuit's misapplication of Rogers, however, not only blurs that line: it conflicts with this Court's historic instructions that reviewing courts must make an independent assessment of "constitutional facts" where First Amendment rights hang in the balance.[8] By treating the issue of "artistic relevance" as one of historical fact for the jury to decide (rather than a mixed question for the court), the Sixth Circuit subjects the First Amendment rights of artists to myriad and unpredictable outcomes. To be sure, some artists can appeal, wasting their money and the judiciaries' resources as each reviewing court "make[s] an independent

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7. Significantly, the book *On the Bus With Rosa Parks*, an anthology of poems by former U.S. poet laureate Rita Dove, is not "about" Rosa Parks. Rather, the book uses the name in the title metaphorically, just as petitioners have done in their song. The only difference is in the content — and the fact that Ms. Parks has not chosen to challenge it.

8. More than eighty years ago, Justice Brandeis, in a characteristically prescient dissenting opinion joined by Justice Holmes, warned that a judge must not "abdicate" the duty of assessing, independently of the jury, constitutional facts affecting freedom of speech. *Schaefer v. United States*, 251 U.S. 466, 483 (1920).

examination of the whole record so as to assure [itself] that the judgment does not constitute a forbidden intrusion on the field of free expression." *Sullivan*, 376 U.S. at 285. But this "constitutional responsibility that cannot be delegated to the trier of fact . . . ," *Bose*, 466 U.S. at 501, *also* applies fully at the summary judgment stage, as recognized in *Rogers*, 875 F.2d at 999 and *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 903 (9th Cir. 2002), *cert. denied*, 123 S. Ct. 993 (2003).[9] If courts fail to fulfill that duty, then to paraphrase *Riley v. National Fed'n of the Blind*, 487 U.S. 781, 794 (1988), "the [songwriter] must bear the costs of litigation and the risk of a mistaken adverse finding by the factfinder," a result which "must necessarily chill speech in direct contravention of the First Amendment's dictates."[10]

In sum, allowing a jury to decide "artistic relevance" under the Panel's formulation of *Rogers* (or to decide whether the title is reasonably 'artistic'" under the Panel's alternative formulation) creates intolerable risks to the First Amendment right to use a controversial title with an expressive work. This is because application of the Panel's "artistic relevance"

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9. The *Rogers* court found summary judgment proper although 38% of those surveyed thought Ginger Rogers had something to do with the movie "Ginger and Fred" and 14% thought she was involved in making the film. For the Court, the risk the public would misunderstand Ms. Rogers' role from the title was "so outweighed by the interests in artistic expression as to preclude application of the Lanham Act." *Rogers*, 875 F.2d at 1001 & n.8.

10. In a recent case, this Court dismissed certiorari as improvidently granted because of the case's procedural posture. *See Nike, Inc. v. Kasky*, 123 S. Ct. 2554 (2003). Shortly thereafter, Nike settled, paying $1.5 million rather than defend its free speech rights. *See* Adam Liptak, *Nike Move Ends Case Over Firms' Free Speech*, N.Y. TIMES, Sept. 13, 2003, at A8. The Sixth Circuit's distortion of the *Rogers* test forces artists and any others who use or want to use a celebrity's name for expressive purposes to face a stark choice: keep silent or pay up to avoid protracted litigation.

standard — not to mention its "reasonably artistic" standard — has "an inherent subjectiveness . . . which would allow a jury to impose liability on the basis of the jurors' tastes or views, or perhaps on the basis of their dislike of a particular expression." *See Hustler*, 485 U.S. at 55. As this Court has stated in a closely analogous context:

> [S]uch a standard applied by a jury under the preponderance-of-the-evidence test, is unlikely to be neutral with respect to the content of speech and holds a real danger of becoming an instrument for the suppression of those 'vehement, caustic, and sometimes unpleasantly sharp attacks' which must be protected if the guarantees of the First and Fourteenth Amendments are to prevail.

Monitor, 401 U.S. at 276-77 (quoting *Sullivan*, 376 U.S. at 270). To avoid these risks, a court must adopt in fact, then rigorously apply, the "any artistic relevance" standard at the summary judgment stage — just as the district judge below did in putting aside her personal views of Defendants' song and "regrettably" granting summary judgment to Defendants. 76 F. Supp.2d at 778 (Pet. App. 53a).

2. The Sixth Circuit's failure to observe the distinction between commercial and non-commercial speech resulted in creation of a "mutant" and unprecedented civil action that unconstitutionally restricts speech about celebrities.

Many lower courts, including the Sixth Circuit, have found that the Trademark Act may only be applied to commercial speech. *See, e.g., The Taubman Co. v. Webfeats*, 319 F.3d 770, 774 (6th Cir. 2003) ("The Lanham Act is constitutional because it only regulates commercial speech"). Within the realm of purely commercial speech, the Trademark Act's permissive standards for imposition of liability and its

robust remedies serve the goal of providing accurate information to consumers and promoting competition, with no countervailing constitutional considerations.[11] But when applied to fully-protected speech in movies and songs — including to their titles — rigorous application of the *Rogers* test is necessary:

> Though First Amendment concerns do not insulate titles of artistic works from all Lanham Act claims, such concerns must nonetheless inform our consideration of the scope of the Act as applied to claims involving such titles. **Titles**, like the artistic works they identify, **are of a hybrid nature**, combining artistic expression and commercial promotion. The title of a movie may be both an integral element of the film-maker's expression as well as a significant means of marketing the film to the public. The artistic and commercial elements of titles are inextricably intertwined. Film-makers and **authors frequently rely on word-play, ambiguity, irony, and allusion in titling their works**. Furthermore, their interest in freedom of artistic expression is shared by their audience. The subtleties of a title can

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11. For example, trademark liability may be imposed whenever a "likelihood of confusion" is found, *see* 15 U.S.C. §§ 1114, 1125(a), a standard which requires only that a significant number of consumers (not a majority) are likely to be misled. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:2, at 23-11 (4th ed. 2002) ("If an appreciable number of reasonable buyers are likely to be confused . . . there is liability for trademark infringement. . . . An appreciable or substantial number of confused consumers does not necessarily mean a majority of such customers."). And, of course, preliminary and permanent injunctions are available and routinely granted in trademark cases. *See* 15 U.S.C. § 1116 (authorizing injunctive relief); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 35 cmt. b (1995).

> enrich a reader's or a viewer's understanding of a work. Consumers of artistic works thus have a dual interest: They have an interest in not being misled and they also have an interest in enjoying the results of the author's freedom of expression. For all these reasons, **the expressive element of titles requires more protection** than the labeling of ordinary commercial products.

Rogers, 875 F.2d at 998 (emphasis added). The *Rogers* test properly distinguishes between expressive (non-commercial) and commercial titles. If a title has any artistic relevance, then its expressive element is paramount, *i.e.*, it is non-commercial speech, and it should not be subject to regulation under the Trademark Act. If the title has no artistic relevance, then there is no reason for treating it differently than "labeling of ordinary commercial products," and it should be subject to regulation under the Trademark Act.

The *Rogers* test for distinguishing commercial and non-commercial titles is consistent with the tests this Court has used to define commercial speech more generally. A title with artistic relevance does "more than propose a commercial transaction." *Posadas de Puerto Rico Assocs. v. Tourism Co.*, 478 U.S. 328, 340 (1986) (quoting *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976)). An artistically relevant title does not relate "solely to the economic interests of the speaker and its audience." *Central Hudson Gas & Elec. v. Public Serv. Comm'n*, 447 U.S. 557, 561 (1980).[12] The Sixth Circuit's

12. The *Rogers* test also reflects one of the key justifications this Court has given for affording lesser protection to commercial speech, namely, that commercial speech is "hardier" than other forms of speech because of the speaker's commercial incentives. *See id.* at 564 n.6 ("[C]ommercial speech, the offspring of economic self-interest, is a hardy breed of expression that is not particularly susceptible to being crushed by overbroad regulation").

opinion ignores this critical distinction. An expressive work that is inconsistent with or even "antithetical" to a celebrity's "qualities" nevertheless will do far more than propose a commercial transaction.

While the Sixth Circuit's disregard for the line between commercial and expressive speech would alone justify this Court's review, the Sixth Circuit's error runs deeper. The Sixth Circuit not only failed to apply the *Rogers* test but also black letter trademark law, reaching the astonishing conclusion that: "If, on remand, the finder of fact determines that OutKast placed the title *Rosa Parks* on a song to which it had no artistic relevance at all, then this would constitute a violation of the Lanham Act and judgment should be entered in favor of Plaintiff." 329 F.3d at 459 (Pet. App. 42a). Thus, under the lower court's view, if a jury found that the title was "antithetical" to Ms. Parks' qualities, then Ms. Parks would not have to prove "likelihood of confusion" or any of the other prerequisites for liability in an ordinary trademark case.

The result is that artistic speech about celebrities is placed in an even less protected position than ordinary commercial speech. It bears repeating: the lower court would deny Defendants' music and other artistic speech the protection available under black letter law in ordinary trademark disputes, instead subjecting such works to a kind of "summary judgment" finding of Lanham Act liability should a jury conclude that such works are inconsistent with the celebrity's qualities. Just this past term, this Court found that over-extension of the Trademark Act's prohibition of false designations of origin "would create a species of mutant copyright law that limits the public's federal right to copy and to use expired copyrights." *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 123 S. Ct. 2041, 2048 (2003) (quotation omitted). The Sixth Circuit decision would now use the Trademark Act to create a species of mutant defamation law, wholly unmoored by the Trademark Act's commercial focus.

Indeed, if the trial courts are permitted to follow the Sixth Circuit's direction, then speech invoking the name of a celebrity will be subjected to repression in a manner that violates both this Court's standard for "non-commercial" speech (which petitioners' song surely is) **and** this Court's standard for "commercial" speech (which requires a showing of likelihood of confusion). At a time when use of celebrity identity is expanding in constitutionally protected works of all kinds — while at the same time celebrity identity is mushrooming in commercial value — the Sixth Circuit leaves artists and public figures/celebrities on a certain collision course. The result will surely be less speech as artists and their publishers shrink from the burden of endless litigation.

3. The lower courts' adoption of conflicting tests for measuring Trademark Act and right of publicity claims against First Amendment standards threatens constitutionally-protected expression.

This Court historically has preserved freedom of speech from intrusion by intellectual property regimes through its interpretation of the fair use doctrine of copyright law. *See, e.g., Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (holding that the Sixth Circuit improperly analyzed fair use protection for a rap parody of the song "Pretty Woman"). Less attention has been devoted to the threats posed by trademark and state right of publicity laws, despite the trend in recent years to use trademarks and celebrity identities to communicate ideas in expressive works. Running parallel to this trend is another trend: the growing use of celebrity identity for product endorsements. Not surprisingly in light of the convergence of these two trends, trademark and right of publicity laws increasingly are being used to prevent "unlicensed" expressive works.

In response, lower courts have applied three contradictory tests to Trademark Act cases involving First Amendment concerns: (1) the "alternative avenues of communication" test; (2) the "likelihood of confusion" test; and (3) the bright line test of *any* artistic relevance, best articulated and applied in *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989). These tests attempt to reconcile the tension between the First Amendment and the Trademark Act, which has been frequently noted by lower courts, although it has not been addressed by this Court. *See, e.g., Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 664 (5th Cir. 2000) ("This case thus involves the tension between the protection afforded by the Lanham Act to trademark owners and the protection afforded by the First Amendment to expressive activity."); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 773 (8th Cir. 1994) ("This case involves the tension between the protection afforded by the Lanham Act to trademark owners and the competing First Amendment rights of the parodist."); *Silverman v. CBS Inc.*, 870 F.2d 40, 48 (2d Cir. 1989) ("Just as First Amendment values inform application of the idea/expression dichotomy in copyright law, in similar fashion such values have some bearing upon the extent of protection accorded a trademark proprietor against use of the mark in works of artistic expression."). Each of these three tests is summarized below:

- Alternative Avenues

The "alternative avenues" approach was applied in the Second Circuit's decision in *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinemas, Ltd.*, 604 F.2d 200, 206 (2d Cir. 1979), which opined that: "Plaintiff's trademark is in the nature of a property right, and as such it need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.'" (quoting *Lloyd Corp. v. Tanner*, 407 U.S. 551, 567

(1972)) (internal cites omitted).[13] The *Dallas Cowboys* court concluded that use of a distinctive cheerleader's uniform in a pornographic film was not protected by the First Amendment. *See id.* at 206 (noting that there were "numerous ways in which defendants may comment on 'sexuality in athletics' without infringing plaintiff's trademark."). The Eighth Circuit has adopted and continues to apply the alternative avenues approach to resolve First Amendment defenses in trademark cases. *See Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) ("[The plaintiff's] trademarks are a form of property, and [the plaintiff's] rights therein in need not 'yield to the exercise of First Amendment rights under circumstances where adequate alternative avenues of communication exist.") (quoting *Tanner* and citing, *inter alia*, *Dallas Cowboys*); *American Dairy Queen Corp. v. New Line Productions, Inc.*, 35 F. Supp.2d 727, 734 (D. Minn. 1998) ("[T]he Court concludes that alternative avenues are available for expressing [the defendant's] ideas.").

The adequate alternative avenues test provides little, if any, protection for First Amendment freedoms. There will rarely be situations where a particular concept or idea can be expressed in one and only one way, and this Court has recognized that tampering with a speaker's choice of words often is akin if not tantamount to censorship. *See Cohen v. California*, 403 U.S. 15, 26 (1971) ("[W]e cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process.").

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13. *See also Reddy Comms., Inc. v. Environmental Action Found., Inc.*, 199 U.S.P.Q. (BNA) 630, 634 (D. D.C. 1977) (rejecting First Amendment defense because "[t]he 'alternative avenues of communication' available to this defendant to express its dissatisfaction with the public utilities would appear infinite. . . . [W]e do not see how defendant's First Amendment rights will be severely hampered if this one arrow is removed from its quiver.").

Finally, the "alternatives avenue" test will inevitably draw courts into the very aesthetic determinations against which Justice Holmes famously cautioned: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903).

The Sixth Circuit's opinion purports to reject the "alternative avenues" test, then a few pages later, argues that "Back of the Bus" would have been an appropriate title for the song because that title was "obviously relevant to the content of the song." 329 F.3d at 453 (Pet. App. 28a). Continuing to steer potential triers of fact to its preferred "alternative" title, the Sixth Circuit observes that *Back of the Bus* "would clearly be artistically relevant" under *Rogers*. *Id.* n.6 (Pet. App. 28a). A few paragraphs later, the Sixth Circuit reiterates "[t]he use of this woman's name unquestionably was a good marketing tool — *Rosa Parks* was likely to sell far more recordings than *Back of the Bus*." *Id.* at 453 (Pet. App. 29a). But, "[t]he song . . . is not titled *Back of the Bus*. It is titled *Rosa Parks*." *Id.* at 454 (Pet. App. 31a). By hammering home "Back of the Bus" as an alternative title, the Sixth Circuit sends a confusing message to trial courts as to the permissibility of "alternative avenues" considerations, thereby leaving juries to weigh the availability of alternative titles consistent with the "qualities" of the public figure.

- Likelihood of Confusion Test

An expressive use of a trademark will, in many instances, be unlikely to cause confusion with the owner of a trademark. Indeed, the District Court in this case held that separate and apart from First Amendment considerations, the defendants'

use of "Rosa Parks" as the title of a song on their *Aquemini* album was unlikely to cause confusion. 76 F. Supp.2d at 783-84. Because the expressive qualities of a First Amendment-protected work may reduce confusion, some courts have mistakenly drawn the conclusion that simple application of the likelihood of confusion test sufficiently protects freedom of expression. *See, e.g., Dr. Seuss Enters. v. Penguin Books USA*, 109 F.3d 1394, 1405 (9th Cir. 1997):

> In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody [protected by the First Amendment] is not really a separate 'defense' as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to the source, sponsorship or approval.

A variant of this approach is to apply the likelihood of confusion test, but to impose the nebulous and frequently meaningless requirement that the finding of likely confusion must be "particularly compelling" in a case involving First Amendment "interests." *See Westchester Media*, 214 F.3d at 664-65.

It is submitted, however, that the standards that protect the public from confusion in conventional trademark disputes are insufficiently robust to protect freedom of expression:

> Our likelihood of confusion test generally strikes a comfortable balance between the trademark owner's property rights and the public's expressive interests. But when a trademark owner asserts a right to control how we express ourselves . . . applying the traditional test fails to account

> for the full weight of the public's interest in free expression.

Mattel, 296 F.3d at 900.[14] Inevitably, litigation over the many factors[15] conventionally applied to assess "likelihood of confusion" will fall far short of providing the "breathing space" that speech requires. For example, in *Dr. Suess Enterprises*, the evidence concerning the likelihood of confusion factors was "indeterminate," 109 F.3d at 1406, and yet this was enough to affirm a preliminary injunction entered against an expressive work. The Ninth Circuit even invoked the rule that "[i]n a close case amounting to a tie, doubts are resolved in favor of the senior user." *Id.* at 1404 n.14. *Dr. Suess* illustrates that under the likelihood of confusion approach an indeterminate record on eight or more fact-intensive marketplace factors can be enough to support an injunction barring protected speech.

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14. *See also* Robert C. Denicola, *Trademarks As Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158, 192 ("As is the case with the confusion rationale, the theories contain internal restrictions that may forestall impermissible expansions of the trademark monopoly, but the limitations are subtle and incomplete; in some instances only direct appeal to constitutional principles can adequately safeguard free speech interests.").

15. The Circuit Courts of Appeal have variously formulated the likelihood of confusion test, but in each, evaluating likelihood of confusion requires examination of numerous "factors," such as the similarity of the marks, similarity of the goods and services, overlaps in the parties' respective channels of trade, the degree of care that prospective purchasers of the goods and services can be expected to exercise, the presence or absence of actual confusion, the intent of the junior user, etc. *See generally* RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 21-23 (1995).

A requirement that a finding of likely confusion be "particularly compelling" does not cure the constitutional ill. In most instances, such an inquiry will simply echo a court's initial conclusion concerning likelihood of confusion. For example, in *Westchester Media*, the court's finding of likely confusion was followed by a single terse paragraph that its finding was "particularly compelling." 214 F.3d at 667-68. Moreover, the likelihood of confusion test ordinarily requires significant litigation; the "particularly compelling" gloss will not enable cases involving artistic expression to be disposed of at any earlier stage in litigation. Finally, the test is highly subjective, and therefore does not provide artists with any guidance concerning the permissibility of their uses of celebrity names.

- Bright Line Test of No Artistic Relevance

In *Rogers v. Grimaldi*, the Second Circuit adopted and applied a clear test for assessing trademark law claims that threaten First Amendment expression. Such claims were barred unless the title has "**no** artistic relevance to the underlying work **whatsoever**, or, if it has some artistic relevance, unless the title explicitly misleads as to the source or the content of the work." *Id.* at 999 (emphasis added). As such, the *Rogers* test avoids the inevitable aesthetic judgments that accompany the "alternative avenues" approach; at the same time, it provides the clarity absent when the "likelihood of confusion" test is applied to protected speech. Indeed, *Rogers* illustrates how the appropriate legal test avoids the pitfalls of the Sixth Circuit's opinion. Thus, *Rogers* did not ask whether the title "Ginger and Fred" was consonant with the "qualities" for which Ginger Rogers was known. Rather, the *Rogers* court examined the work and the title, found that the minimal threshold of any artistic relevance was present, and affirmed summary judgment granted in the defendants' favor.

- Intracircuit Conflict Concerning the Appropriate Test

Not only are there three competing approaches among the circuits; in several circuits there are panel decisions which are extraordinarily difficult to reconcile with one another. In the Second Circuit, *Rogers*, as noted, rejected the "alternative avenues" approach earlier adopted in *Dallas Cowboys*. Later Second Circuit precedent, however, has given way to a "likelihood of confusion" approach amplified only by the nebulous requirement that the finding of confusion be "particularly compelling." *See, e.g.*, *Twin Peaks*, 996 F.2d at 1379 ("[T]he finding of likelihood of confusion must be particularly compelling to outweigh the First Amendment interest recognized in *Rogers*."). Moreover, in the Ninth Circuit, the *Mattel* opinion adopting *Rogers* is in serious tension with *Dr. Suess*, in which First Amendment interests were given extremely short shrift under a "likelihood of confusion" type approach.

Lastly, there is palpable tension in the Sixth Circuit itself, where a painter recently was allowed to use a sports figure's entire image and likeness as the very centerpiece and foundation of his artwork — because the art was related to the athlete's accomplishments — yet Petitioners were not allowed to use a public figure's name as the title of one song on a fifteen-track album, even though their music was obviously linked to the most notable event in that public figure's life. The results and reasoning of *ETW Corp. v. Jireh Publ'g*, 332 F.3d 915 (6th Cir. 2003) and this case are irreconcilable.

- Summary

The tension between the First Amendment and trademark law has engendered deep divisions both across and within the judicial circuits. Ambiguity in the standard for First Amendment protection will inevitably lead artists and others

to avoid legal exposure by censoring themselves. Differences among the circuits may invite powerful celebrities to forum shop in their efforts to suppress speech that is unhelpful to the commercial licensing of their identities. This Court should provide uniform constitutional safeguards for expressive works that are increasingly being attacked under trademark and right of publicity theories.

CONCLUSION

As *Rogers* reminds us, "The subtleties of a title can enrich . . . understanding." 875 F.2d at 998. That is one reason for insisting on a constitutional bright line; for it is only such a standard that guarantees the breathing space creative speech requires. The Sixth Circuit constricts that space, subjecting artistic works that controversially use celebrity names to a scrutiny that few writers will willingly endure. Because of the opinion's impermissible chilling effect on speech, Petitioners respectfully urge review by this Court.

Respectfully submitted,

JOSEPH M. BECK
Counsel of Record
CHRISTOPHER J. KELLNER
KILPATRICK STOCKTON LLP
1100 Peachtree Street
Suite 2800
Atlanta, GA 30309-4530
(404) 815-6500

Attorneys for Petitioners